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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/099,966	03/19/2002	Hiromi Ukai	62807-015	7234

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McDermott, Will & Emery  
600 13th Street, N.W.  
Washington, DC 20005-3096

EXAMINER
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CARLSON, JEFFREY D

ART UNIT	PAPER NUMBER
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3622

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/099,966	<b>Applicant(s)</b> UKAI ET AL.	
	<b>Examiner</b> Jeffrey D. Carlson	<b>Art Unit</b> 3622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 October 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 11,13,15,17,20,21 and 23-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11,13,15,17,20,21 and 23-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This action is responsive to the paper(s) filed 10/27/06. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 15, 20, 21, 23-27, 29, 31-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 15 part (2), it is unclear how a means for receiving a request can be defined/limited by language alluding to the basis for the generation of the request. It is unclear how the "transmitted on the basis of the coupon information" limits the means for receiving a request beyond the simple notion that a request can be transmitted. An example: If the receiving means were a baseball mitt, the mitt cannot be defined by describing how/why a ball is thrown (left handed, right handed, underhand, overhand) towards the mitt.
- Claims 20, 21, 23-27, 29, 31-33 are of unclear claim scope because they set forth performance of method steps rather than structure (programmed capability). It is not clear what structure is responsible for each of the steps

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(broadcasts, sets, generates, inserts, selects, request is attached with, calculates, obtains, etc.).

- Claim 23, it is unclear how a coupon can be broadcasted, especially at the time when the program or commercial message is broadcasted.
- Claim 31 it is unclear how the coupon request can include the time when the coupon is (subsequently) received.
- Claims 32, 33, it is unclear how an means for attachment can be limited by describing where the data comes from. The capability to attach would be the same regardless of the source of the data to attach.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. **Claims 11, 13, 15, 17, 20, 21 and 23-33 are rejected under 35 U.S.C. 102(e) as being anticipated by Spector (US 2006/0100929).**

Regarding claims 11, 15, Spector teaches a user's TV receiving device that receives broadcasted/transmitted television content including a commercial. The customer is given the chance to request a coupon for the product offered in the commercial and he may make such a request using the remote control [para 32]. The presence of the

commercial itself represents coupon information that a coupon request can be made. The request includes an identification of the product, viewer profile information and timing information and what specific commercial was being shown at the time [para 16, 22, 30, 33]. A coupon is then retrieved from coupon storage and issued based on the request [37]. A central host computer also monitors the number of coupon responses (requests) and redemptions in order to manage and nimbly makes changes to the coupon campaign operations [para 23, 24, 34, 35, 39]. The steps of reactively modifying a particular product's coupon campaign based upon collected coupon usage (responses and redemptions) inherently provides a calculation regarding the number of issuances and redemptions for that product/commercial's coupons. As the coupon requests are tied to a specifically identified product commercial (using embedded identification information), it can be said that Spector calculates a number of issued coupons for the commercial message on the basis of the extracted identifier. Regarding the "determining a period, number of times or a fee, for the broadcasting or transmitting of the program or commercial message", the ability to calculate a number of issuances of coupons inherently provides a number of minimum times that the corresponding commercial was broadcasted and/or viewed, therefore meeting this limitation.

Regarding claims 13, 17, Spector teaches receiving usage (redemption) information [para 34]. Again, the steps of reactively modifying a particular product's coupon campaign based upon collected coupon usage (responses and redemptions) inherently provides a calculation regarding the number of issuances and redemptions for that product/commercial's coupons. Regarding the "determining a period, number of times or a fee, for the broadcasting or transmitting of the program or commercial message", the ability

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to calculate a number of redemptions of coupons inherently provides a number of minimum times that the corresponding commercial was viewed, therefore meeting this limitation.

Regarding claims 20, 25, the facility that delivers the program or commercial message which includes the coupon information is taken to be a data broadcasting line.

Regarding claims 21, 24, 26, 27, as the issuances and redemptions increase, the inherently associated number of minimum commercial broadcasts/views increases.

Regarding claim 23 as best understood, the facility that delivers the coupon is taken to be a data broadcasting line.

Regarding claims 28, 30, Spector teaches including the time of the commercial as part of the coupon request [para 30].

Regarding claims 32, 33, Spector teaches that the TV receivers are personal video recorders (PVRs) and that these devices allow a user to record a plurality of shows and watch them later. In particular, the shows are indexed for later selection/viewing. This indexing and inherent user interface which enables particular shows to be selected from a list of recorded shows is taken to provide an electronic program guide which identifies each show. The ability to request from a host a coupon related to a particular broadcasted commercial using such a PVR is therefore taken to include identification of the time/show being viewed so that the proper coupon can be issued.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**7. Claim 31 is are rejected under 35 U.S.C. 103(a) as being unpatentable over Spector.**

Regarding claim 31, Spector teaches that demographic profile information is sent as part of the request [para 22, 30, 33] and that this demographic profile information is used to target the coupon. Spector however does not specifically teach gender or age. However, Official Notice is taken that it is well known to collect demographic information (including gender, age and other characteristics) about coupon users (as well as television viewers) in order to provide insight to the coupon (and TV) behavior of various demographic segments. It would have been obvious to one of ordinary skill at the time of the invention to have determined the coupon and/or TV behavior of various demographically-segmented users' of Spector in order to use the gained knowledge for better marketing decisions when dealing with these groups of consumers. Regarding the times of the requests/issuances and redemptions, Spector teaches that the coupon offers are short life coupons which indicates the need to calculate redemption-issue times to verify the validity of the short-life coupon.

***Claim Rejections - 35 USC § 103***

**8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior

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art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**9: Claims 11, 13, 15, 17, 20, 21 and 23-33 are alternatively rejected under 35**

**U.S.C. 103(a) as being unpatentable over Spector in view of Kitsukawa et al**

**(US6282713).**

Kitsukawa et al also teaches delivery of electronic coupons to users via broadcast television content. Kitsukawa et al teaches that the user can be notified of the availability of a coupon, that the user can select the coupon and that the system will store information concerning the broadcasted content when the coupons were delivered - program title, program description, air date/time and channel [11:48-54]. Upon redemption, this data is accessed and the central host includes storage of these coupon identifiers along with the broadcast content information [12:9-20] to allow for "statistical television data." It would have been obvious to one of ordinary skill at the time of the invention to modified Spector to collect and analyze the TV programming data which acted as a source of the requested coupons so that marketing decision makers can better understand the TV programming, TV audience behavior, and their participation in the coupon campaign, in order to optimize future coupon campaigns. It would have been obvious to one of ordinary skill at the time of the invention to have collected statistical television data as suggested by Kitsukawa et al in order to determine the relative success of the coupons (number of requests, number of redemptions, elapsed time before redemption) for each of the associated broadcasts in order to provide basic Marketing insight, especially as applicant has indicated that audience rate of a broadcast program has conventionally been used [spec page 2 lines 10-12].



While the notion set forth above that Spector's ability to calculate a number of issuances/redemptions of coupons inherently provides a number of minimum times that the corresponding commercial was broadcasted/viewed indeed meets the determining a period, times or fee limitation, Kitsukawa et al clearly teaches the idea of studying TV-coupon requests/issuances and redemptions in order to provide marketing analysis regarding both couponing and television viewing. Official Notice is taken that it is generally accepted practice to charge advertisers for the service of broadcasting advertisements. It would have been obvious to one of ordinary skill at the time of the invention to have charged the manufacturers of the products in the broadcasted coupons according to the quantity of coupons that were broadcast, issued and/or redeemed on their behalf. In this manner, the advertiser pays a fee that is commensurate in scope with the advertising/coupon/promotional broadcast service.

Regarding claim 29 in particular, Kitsukawa et al teaches that several coupons can be available at a single time for a TV viewer. Kitsukawa et al provides storage of coupons by way of pointers that enables the plural coupons to be managed and more specifically to be uniquely identified [col 6 lines 5-13]. It would have been obvious to one of ordinary skill at the time of the invention to have inserted a coupon identifier at the host of Spector so that the programs/commercials can be broadcasted with embedded coupon identifiers, allowing users to accurately identify desired coupon when plural coupons are shown at the same time.

Regarding claims 32, 33, Kitsukawa et al teaches that program content is classified (i.e. identified) by the receiver's electronic program guide (EPG) [col 5 lines 32-35]. It would have been obvious to one of ordinary skill at the time of the invention to have

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used such identification data in order to notify the host of the program being watched in association with the requested coupon in order to enable the statistical analysis of uniquely identified coupons and related programming as desired by Kitsukawa et al.

### ***Response to Arguments***

Applicant's arguments are moot in view of the new grounds of rejection presented.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Nemirofsky et al (US5880769) has been cited because it teaches delivery of electronic coupons through a TV broadcast, but more importantly it teaches that it is known to analyze coupon redemption data and further suggests encoding the following information onto a TV-sent coupon: NSC code, userID, manufacturerID, offered, demographics, psychographics, as well as TV programID. He teaches that all of this information can be measured and analyzed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey D. Carlson whose telephone number is 571-272-6716. The examiner can normally be reached on Mon-Fri 8a-5:30p, (work from home on Thursdays).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571)272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Jeffrey D. Carlson  
Primary Examiner  
Art Unit 3622

jdc